REMARKS

Claims 1 and 49-72 are pending in this application.

Applicants have amended Claims 65-68 to correct obvious typographical mistakes. Applicants submit that these amendments do not narrow the scope of the amended claims. Applicants have also amended Claim 70 to clarify the subject matter claimed. Support can be found, for example, on page 9, 3rd full paragraph.

Applicants respectfully request reconsideration and withdrawal of the rejections in view of the arguments set forth below.

Rejection of Claims 1, 49, 54-66, 70, and 71 Under 35 U.S.C. § 102(b) in view of Eicher et al. (PCT publication WO 97/03718)

Claims 1, 49, 54-66, 70 and 71 remain rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Eicher *et al.* The Office Action reiterates the rejection of record verbatim, and alleges that col. 4, lines 12-30 of Eicher disclose that the substrate and/or microneedles are formed from flexible materials.

In the Response to Arguments section, the Office Action contends that "the broadly classified group of thermoplastic materials inherently include materials that are flexible. Even Applicant herself has admitted that 'materials commonly referred to as 'plastic' may range from being extremely pliable (to indestructable (and certainly inflexible) hard plastic)...'"

In essence, the Office Action rejects the claimed invention on the basis that the broadly disclosed genus of "thermoplastic materials" allegedly anticipates the claimed species of "flexible material." Applicants respectfully disagree.

There is no doubt that a species will anticipate a claim to a genus. *In re Slayter*, 276 F.2d 408, 411 (CCPA 1960); *In re Gosteli*, 872 F.2d 1008 (Fed. Cir. 1989). Also *see* MPEP 2131.02. However, the reverse is generally not true, *i.e.*, a broadly disclosed genus generally does not anticipate a species within the genus, unless: (1) such a species is "clearly named," or (2) "when the species can be 'at once envisaged' from the (genus) formula." MPEP 2131.02.

Eicher does not "clearly name" the recited "flexible material." The Office Action fails

to specifically point out where in Eicher such "flexible material" is disclosed. Neither can Applicants identify such a disclosure in Eicher.

Applicants also submit that a skilled artisan cannot "at once envisage" the recited flexible material from the broad Eicher disclosure of "thermoplastic materials," such as polyethylene, *etc.* Applicants wish to draw the Examiner's attention to the controlling case law *Akzo N.V. v. International Trade Comm'n*, 808 F.2d 1471 (Fed. Cir. 1986).

In *Akzo*, claims to a process for making aramid fibers using a 98% solution of sulfuric acid were found not anticipated by a cited reference, which disclosed using sulfuric acid solution, but which did not disclose using a 98% concentrated sulfuric acid solution. The Federal Circuit, after reviewing the International Trade Commission (ITC) investigation record, held that the factual findings of the Administrative Law Judge (ALJ) presiding over the investigation were supported by substantial evidence. Thus the court affirmed the ALJ conclusion that "sulfuric acid in any concentration was not disclosed as a solvent in the reference." *Akzo*, 808 F.2d at 1480. The court also found that the ALJ properly relied on *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972) to reject "random picking and choosing" of prior art, and affirmed the ALJ conclusion that "the anticipatory reference must disclose in the prior art a thing substantially identical with the claimed invention. In a somewhat more limited consideration - restricted to the concentration of sulfuric acid in the Blades patent" (emphasis added). *Akzo*, 808 F.2d at 1480.

If "sulfuric acid solution" does not anticipate the claimed "98% concentrated sulfuric acid solution," Applicants submit that "thermoplastic materials" cannot anticipate "flexible (thermoplastic) materials." The Examiner admits that thermoplastic material is a "broadly classified group." Therefore, a skilled artisan could not "at once envisaged" from this broad genus any specific species, such as those species materials that are flexible.

Therefore, Applicants submit that Eicher does not anticipate the claimed invention. Reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(b) are respectfully requested.

Claim Rejections under 35 U.S.C. § 103(a)

Claims 50-53 stand rejected under 35 U.S.C. § 103(a) as allegedly obvious over Eicher *et al.*

Claims 67 and 68 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Eicher *et al.* in view of Gerstel *et al.* (US 3,964,482).

Claims 69 and 72 stand rejected under 35 U.S.C. §103(a) as allegedly being obvious over Eicher *et al.* in view of Godshall *et al.* (US 5,879,326).

The Office Action reiterates the rejection of record verbatim.

As discussed above, Applicants reiterate that the claims, as amended, recite features neither disclosed nor suggested by Eicher. Neither Gerstel nor Godshall teach or suggest the subject matter recited in the amended independent Claims 1 and 70, from which Claims 50-53, 67-69 and 72 depend. Claims 67-69 and 72 are therefore patentable for the same reasons that Claims 1 and 70 are patentable. Thus, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a).

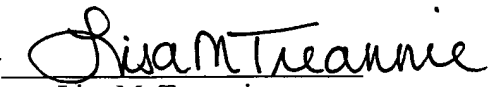
CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

We believe that we have appropriately provided for fees due in connection with this submission. However, if there are any other fees due in connection with the filing of this Response, please charge the fees to our Deposit Account No. 18-1945, referencing the attorney docket number listed above.

Dated: April 18, 2006

Respectfully submitted,

By 

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